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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,969	12/01/2003	Jordi Albornoz	POU920030183US1	3005

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CANTOR COLBURN LLP-IBM POUGHKEEPSIE
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EXAMINER

WALSH, JOHN B

ART UNIT	PAPER NUMBER
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2151

MAIL DATE	DELIVERY MODE
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01/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/724,969

Applicant(s)

ALBORNOZ ET AL.

Examiner

John B. Walsh

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/1/03; 2/20/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 27-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 27 and 28 are drawn to a computer data signal. (See also paragraph 0042 of corresponding PGPUB wherein the signal is drawn to transmission media). Signals are non-statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1- 28 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication 2001/0037453 to Mitty et al.

As concerns claims 1 and 27 as best understood, a network communication system for instant messaging comprising: a client-server network system (0011; 0048) with a server in communication with a client and a server and a network for communication therebetween, each of said server and said client operating as at least one of a sender (0011) and a recipient (0011) of a combined message; wherein said combined message includes a code (0012) and a communications message (0012); and wherein said

sender transmits at least one of said code and said combined message to said recipient (0012).

As concerns claims 2, 14, 26 and 28 as best understood, executing said code to establish at least one of: modifying a persistent state associated with said recipient based on said code to indicate whether a selected communications message should be delivered and delivering said communications message; and establishing said code as a predicate for evaluating whether a selected communications messages should be delivered; returning a function value indicative thereof; and transmitting said communications message if said function value indicates said communications message should be delivered (0086;0094).

As concerns claims 3 and 15, further including a state variable associated with said recipient (0032;0086).

As concerns claims 4 and 16, wherein said state variable corresponds to one or more aspects of a state of said recipient (0086).

As concerns claims 5 and 17, wherein said state variable is name spaced based on a selected sender of a message (0086).

As concerns claims 6 and 18, wherein said state variable includes at least one of a function and one or more parameters (0086; 0059).

As concerns claims 7 and 19, wherein said parameters include at least one of a state variable name, a sender, and a recipient (0032, 0086).

As concerns claims 8 and 20, wherein said state variable is at least one of modified by a sender, determined by selected code operating at said recipient, and updated by selected code operating at said recipient (0086; 0094;0120).

As concerns claims 9 and 21, further including storing a state variable on a server separate from a recipient (0048- intermediary 115;0053).

As concerns claims 10 and 22, wherein said code evaluates a state of said recipient (0086).

As concerns claims 11 and 23, wherein said a state of said recipient includes whether a messages has been previously received (0086).

As concerns claims 12 and 24, further including establishing a security mechanism at a recipient to ensure that code transmitted to, and executed at, a recipient is noninvasive (0022).

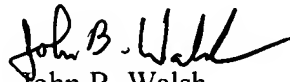
As concerns claims 13 and 25, a method for instant messaging in a network communication system comprising: formulating a combined message to a recipient (0011), said combined message including a code (0012) and a communications message (0012); and transmitting at least one of said code and said combined message to a recipient (0012).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John B. Walsh
Primary Examiner
Art Unit 2151